



Rec'd PCT/PTO 02 FEB 1998

122-130

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

LUKAS-LASKEY et al

164 6-10-98

164 14
Spivack

Serial Number: 08/875,603

RECEIVED

MAR 19 1998

Filed: August 4, 1997

MATRIX CUSTOMER
SERVICE CENTER

For: USE OF CARBAZOLE COMPOUNDS FOR THE TREATMENT OF CONGESTIVE
HEART FAILURE

PETITION FOR RETROACTIVE FOREIGN FILING LICENSE UNDER 35 USC 1.84

Assistant Commissioner
of Patent
Washington, D.C. 20231

RECEIVED

February 2, 1998

JUN 5 1998

Sir:

This petition for a Retroactive Foreign Filing License is with respect to the above-identified application. The above-identified application is directed to the use of certain carbazole compounds for the treatment of congestive heart failure.

The application does not disclose an invention within the scope of 35 USC 1.81, was not under a secrecy order at the time it was filed abroad, and is not currently under a secrecy order.

At least part of the above application was originally filed as German Patent Application No. 19503995.5 on February 8, 1995.

This petition for a Retroactive License has been diligently sought after discovery of the inadvertent foreign filing.

Attached is the declaration of Dr. Manfred Weber, a member of the Patent Department of Boehringer Mannheim GmbH. A sister company, Boehringer Mannheim

Pharmaceuticals Corp., is one of the two corporate partners to whom the present U.S. application is assigned. As will be noted from Dr. Weber's declaration, when he filed the German patent application, he did not consider the fact that U.S. inventors could be involved, as no identification of the inventors accompanied the German application papers. It was not until early December 1997 (Dr. Weber's contains a typographical error with respect to the date in paragraph 5, as the undersigned attended the meeting in question and verifies that the correct date is December 1-2, 1997) that the question of a foreign filing license arose, and the decision was made to file this request for a retroactive foreign filing license.

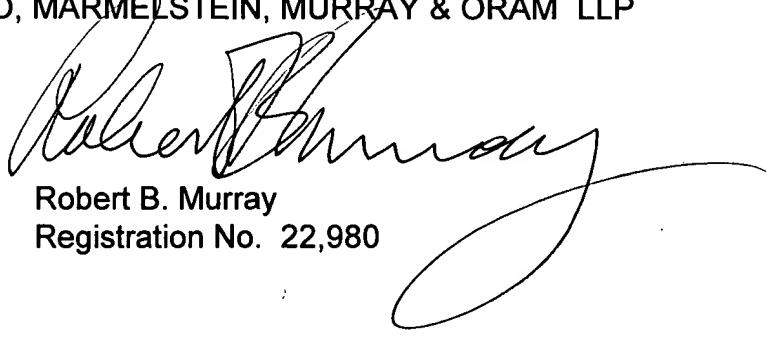
Part of the subject matter of the present application was inadvertently filed abroad through error and without deceptive intention, since under German law the inventors need not be identified at the time of filing a patent application, and Dr. Weber had thus not considered the inventorship of the German application. The enclosed declaration is thus by the person having personal knowledge of the acts regarding filing in the foreign country in question.

Since this retroactive license has been diligently sought, since the application was filed abroad through error and without deceptive intention, and since the application does not disclose an invention within the scope of 35 USC 1.81, it is respectfully requested that the Commissioner grant this petition for a retroactive license.

A check in the amount of One Hundred Thirty Dollars (\$130) to cover the cost of the petition fee is attached.

In the event any fees are required, please charge our Deposit Account No. 14-1060.

Respectfully submitted,
NIKAIDO, MARMELSTEIN, MURRAY & ORAM LLP


Robert B. Murray
Registration No. 22,980

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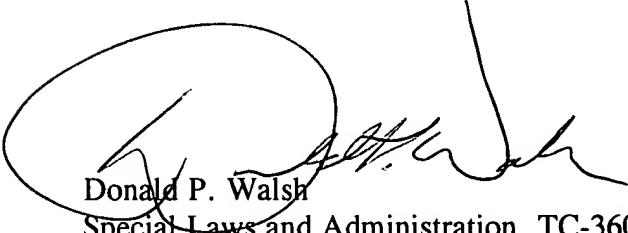
Telephone: (202) 638-5000

RBM/cb
Ck 15541

**DECISION ON REQUEST
FOR RETROACTIVE LICENSE
UNDER 37 CFR 5.25**

Petition No.: 08/875,603
Request Filed: 2/2/98

In view of the above identified communication, it has been determined that a retroactive license for foreign filing under 35 U.S.C. 184 be granted with respect to the filing(s) and date(s) listed in applicants petition. The petition complies with 37 C.F.R. 5.25 in that there is an adequate showing that the subject matter in question was not under secrecy order, that the license was diligently sought, and that the material was filed abroad without the required license under 37 C.F.R 5.11 first having been obtained through error and without deceptive intent.



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